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*AS*

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.

EXAMINER
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ART UNIT	PAPER NUMBER
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*10***DATE MAILED:**

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

## Office Action Summary

Application No. 09/558,329	Applic. (s)	Stern et al.
Examiner Cheryl Juska	Group Art Unit 1771	

Responsive to communication(s) filed on Jan 10, 2001

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle* 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133) Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

### Disposition of Claim

Claim(s) 1-87 is/are pending in the application

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration

Claim(s) \_\_\_\_\_ is/are allowed.

Claim(s) 1-87 is/are rejected.

Claim(s) \_\_\_\_\_ is/are objected to.

Claims \_\_\_\_\_ are subject to restriction or election requirement.

### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been received

received in Application No. (Series Code/Serial Number) \_\_\_\_\_

received in this national stage application from the International Bureau (PCT Rule 17.2(a))

\*Certified copies not received: \_\_\_\_\_

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

### Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s) \_\_\_\_\_

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## **DETAILED ACTION**

### ***Reissue Applications***

1. The original patent, or an affidavit or declaration as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.

### ***Oath/Declaration***

2. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

Non-initialed and/or non-dated alterations have been made to the oath or declaration. See 37 CFR 1.52(c).

The citizenship of inventor Michael N. Byles has been changed, but no initials are present.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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4. Claims 30-87 stand rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. The dual layer of a hydrophobic/hydrophilic felt web which is critical or essential to the practice of the invention, but not included in the claims is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). Additionally, said claims are rejected under 112, 1st for being broader in scope than the disclosure of the invention. The specification, while being enabling for a web comprising a hydrophobic component and a hydrophilic component, does not reasonably provide enablement for a web not limited to including both phobic and philic components, as is recited in claims 30-87. Said rejections are maintained from the last Office Action, section 3.

*Response to 112, 1st Arguments*

5. Applicant's arguments filed in the Response to Official Action, Paper No. 9 filed on January 10, 2001, have been fully considered but they are not persuasive.

6. Applicant traverses the above 112, 1st enablement rejections by asserting that *In re Mayhew* does not support said rejection. Specifically, Applicant states, "Thus, *Mayhew* stands for no more than that the critical elements of a functional invention must be present in the claims to be enabling, whereas lack of specific properties of those elements is not fatal to the claims." (Response, sentence spanning pages 2-3.) Applicant asserts the critical elements (i.e., "yarns and felt, which are necessary ingredients for a stitch bonded fabric of the invention") are recited, while

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the preferred properties of the felt (i.e., "hydrophobic and/or hydrophilic") need not be present in the claims (Response, page 3, lines 2-7).

7. The Examiner respectfully disagrees. It is reiterated that the entire disclosure of the invention is directed to a *dual* layer stitch-bonded felt web. Specifically, the *Abstract, Summary of the Invention* (col. 1, lines 47-51), *Figures 2, 5, and 6-8* (reference numbers **14** and **16**), *Detailed Description* (particularly, col. 2, lines 31-47 and col. 3, lines 20-23), and the allowed claims of the parent application all teach that the stitch-bonded felt web is comprised of a dual layer of hydrophobic fibers and hydrophilic fibers. The Examiner contends that the critical element missing from claims 30-87 is the *dual* layer of the felt web. The nature of the dual layer is defined by the combination of hydrophobic and hydrophilic layers. Thus, the Examiner asserts that phobicity and philicity are not merely *preferred properties*, but are essential to the nature of the invention.

8. In support of the Examiner's position, as was previously stated, the disclosure teaches "The present invention provides an improved *fluid-retaining fabric* such as may be *substituted* for the *facing fabric and felt* of the prior incontinent pads." (Col. 1, lines 44-46.) "Facing fabrics" are defined by the disclosure as a layer of an incontinent pad which functions to wick away fluid from a wearer's skin, thus providing a dry, comfortable surface against the skin (col. 1, lines 11-28). The disclosure defines the "felt" layer as functioning to absorb and retain fluids (col. 1, lines 11-28). Thus, it is reasserted that the present invention is directed to an improved *single* fabric which must perform *both* the wicking function of a facing fabric through the hydrophobic

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component and the absorption function of felt web through the hydrophilic component. Hence, the inventions of claims 30-87 are non-enabling in that all claims are drawn to stitch-bonded single component webs which are unable to perform the dual functions required for the inventive fluid-retaining fabric.

9. Additionally, in support of the Examiner's position, it is noted that the inventive "improved facing fabric" "incorporates the advantageous features of a felt layer *without the added cost of separate manufacture of the facing fabric and the felt*, and without the cost of the still-further quilting process" (col. 1, lines 63-67). Hence, another object of the present invention is to reduce cost by *combining* the dual functions of the facing and the felt into a single manufacturing step. Thus, claims 30-87 are non-enabling for such a disclosure, in that said claims are drawn to a single layer with a unitary function.

10. Furthermore, with respect to the scope of enablement rejection of claims 30-87, it is reiterated that said claims encompass embodiments which are not enabled by the disclosure. For example, claims 30 and 39 encompass a stitch-bonded fiberglass web, which is not enabled by the specification, nor would said fiberglass web be suited for the objects of the invention as originally disclosed. Additionally, claims 58 and 70 encompass a stitch-bonded polytetraflouroethylene (hydrophobic) web, which is not enabled nor suitable for performing the function of the invention as intended. Furthermore, claims 65 and 80 encompass a stitch-bonded silk (hydrophilic) web, which is also not enabled or suited for the intended function of the originally disclosed invention.

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11. In response to Applicant's argument that the critical or essential feature of the invention is that the yarns are stitch-bonded so as to create yarn faces which cover the visibility of the felt (Response, page 3, lines 8-12), it is asserted that said feature is not disclosed as being an *object of the invention*, much less being *critical* to said invention. What is critical to the invention is the combination of hydrophobic and hydrophilic fibers necessary to carry out the intended dual function of said invention.

12. With respect to Applicant's argument that the Examiner "alleges that all prior art pads have combined hydrophobic and hydrophilic components in the facing fabric" (Response, page 4, lines 1-12), it asserted that said argument is erroneous. It was not the intention of the Examiner to assert *all* prior facing fabrics have dual components. It was merely noted that Comply<sup>x</sup>, much like the present invention, is an exemplary facing fabric which incorporates the dual functions of a facing fabric and an absorbent felt layer into a single "facing" layer (col. 1, lines 28-35). Thus, the Examiner was not 'inferring that all other facing fabrics could be ignored' as is asserted by the Applicant (Response, page 4, lines 13-19).

13. With respect to Applicant's assertion that while "specific embodiments" of the invention include a specific combination of the hydrophobic and hydrophilic components, the invention "is not so limited" (Response, sentence spanning pages 4-5), it is reiterated that the object of the invention is to provide a fabric which incorporates the functions of a conventional facing fabric and a conventional absorbent web into a single fabric which can be produced less expensively. As

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such, it is reasserted that the present invention *is* limited to the inclusion of the dual phobic/philic combination. In *The Gentry Gallery, Inc. v. The Berkline Corp.*, 134 F.3d 1473, 1479-80, 45 USPQ2d 1498, 1503 (Fed. Cir. 1998), the court acknowledged that while a claim may be broader than the specific embodiment disclosed in the specification, the “claims may be no broader than the supporting disclosure.” Thus, a narrow disclosure will limit claim breadth.

14. In response to the assertion that one skilled in the art would not require “undue experimentation” to determine suitable felt webs for the present invention (Response, page 5, line 3-page 6, line 2), it is noted that the Examiner has not argued lack of enablement requiring undue experimentation. Rather, the above enablement rejections are based upon (a) an element critical or essential to the practice of the disclosed invention is missing from claims 30-87 and (b) the scope of any enablement provided to one skilled in the art is not commensurate with the scope of protection sought by claims 30-87. The Examiner agrees that the claimed subject matter which includes dual phobic/philic components is fully enabled, despite a lack of specifics to said phobic/philic components. Although Applicant does not clearly disclose how to make a hydrophobic or hydrophilic web (i.e., method of web formation, method of bonding said web, suitable fibers, etc.), this information is well-known in the art. As such, one of ordinary skill in the art would not require undue experimentation to determine how to make and use a stitch-bonded web comprising hydrophobic and hydrophilic components. Therefore, said information need not be described in the specification.

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Applicant continues to argue that "a broad claim can be enabled by the disclosure of a single embodiment" (Response, page 6, line 3-page 7, line 7). The Examiner does not disagree with this statement. However, the full scope of said broad claim must enable the invention to function as intended. Claims 30-87 do not, in that hydrophobic and hydrophilic components are critical for the practice of the invention as originally disclosed. Therefore, the 112, 1st rejections of claims 30-87 are hereby maintained.

***Claim Rejections - 35 USC § 102***

15. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

16. Claims 65 and 67-69 stand rejected under 35 U.S.C. 102(b) as being anticipated by the cited Sternlieb patent as set forth in section 8 of the last Office Action.

17. Claims 30-37 and 51-64 stand rejected under 35 U.S.C. 102(b) as being anticipated by the cited Lefkowitz patent as set forth in section 9 of the last Office Action.

18. Claims 30, 32-37, 51, 53-56, 58, 59, 61-66, 68, and 69 stand rejected under 35 U.S.C. 102(b) as being anticipated by the cited Ott patent as set forth in section 10 of the last Office Action.

19. Claims 30, 32-36, 39, 41, 42, 46-51, 53-56, 65, 68, 69, 80, 83, 84, 86, and 87 stand rejected under 35 U.S.C. 102(b) as being anticipated by the cited Gillies patent as set forth in section 11 of the last Office Action.

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***Claim Rejections - 35 USC § 103***

20. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

21. Claims 1, 3-9, 12, 14-20, 23, 26-29, 37, 38, 43, 58, 61-64, 66, 70, 71, 73, 74, 76-79, and 81 stand rejected under 35 U.S.C. 103(a) as being unpatentable over the cited Gillies patent in view of the cited Ott patent, as set forth in section 13 of the last Office Action.

22. Claims 10, 11, 21, 22, and 57 stand rejected under 35 U.S.C. 103(a) as being unpatentable over the cited Gillies patent in view of the cited Ott patent as applied to claims 1, 12, and 51 above, as set forth in section 14 of the last Office Action.

23. Claim 25 stands rejected under 35 U.S.C. 103(a) as being unpatentable over the cited Gillies patent in view of the cited Ott patent, as applied to claim 23 above, and in further view of the cited Lefkowitz and Kyle patents, as set forth in section 15 of the last Office Action.

24. Claims 40 and 82 stand rejected under 35 U.S.C. 103(a) as being unpatentable over the cited Gillies patent in view of the cited Taylor patent as set forth in section 16 of the last Office Action.

25. Claims 24 and 72 stand rejected under 35 U.S.C. 103(a) as being unpatentable over the cited Gillies patent in view of the cited Ott patent, as applied to claims 23 and 70 above, and in further view of the cited Taylor patent as set forth in section 16 of the last Office Action.

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26. Claims 31, 44, 45, 52, 67, and 85 stand rejected under 35 U.S.C. 103(a) as being unpatentable over the cited Gillies patent in view of the cited Sternlieb patent, as set forth in section 17 of the last Office Action.

27. Claims 2, 13, 59, 60, and 75 stand rejected under 35 U.S.C. 103(a) as being unpatentable over the cited Gillies patent in view of the cited Ott patent, as applied to claims 1, 12, 58, and 70 above, and in further view of the cited Sternlieb patent, as set forth in section 17 of the last Office Action.

28. Claims 1-23, 25-39, 41-71, 73-81, and 83-87 stand rejected under 35 U.S.C. 103(a) as being unpatentable over the cited Kyle patent in view of the cited Gillies, Ott, and/or Sternlieb patents as set forth in section 18 of the last Office Action.

29. Claims 24, 40, 72, and 82 stand rejected under 35 U.S.C. 103(a) as being unpatentable over the cited Kyle patent in view of the cited Gillies, Ott, and/or Sternlieb patents, as applied to claims 23, 39, 70, and 80 above, and in further view of the cited Taylor patent as set forth in section 19 of the last Office Action.

#### *Response to Prior Art Arguments*

30. With respect to the Sternlieb anticipation rejection, Applicant notes that the stitch-bonded fabric has only one face of stitch yarns (Response, page 9, lines 8-10). The other face shows the stitches 'embedded' in the web, rather on the surface of said web (Sternlieb, Figure 7). Thus, the 102 rejection of claims 30-36 and 51-56 has been withdrawn in that Sternlieb teaches away from

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having two faces of stitch yarns, as is presently recited in independent claims 30 and 51.

However, the rejection of claims 65 and 67-69 as being anticipated by Sternlieb is maintained due to only one yarn face being recited in said claims.

31. With respect to the Lefkowitz anticipation rejection, Applicant argues that the spacing of the stitch yarns is significant (Response, page 9, lines 10-12). As such, Applicant believes the present invention is distinguished from said Lefkowitz patent. The Examiner respectfully disagrees. The term yarn face does not limit the spacing of the yarn stitches. In a broad sense, said term merely limits the stitch yarns to being on the surface of said web (as opposed to the 'embedded' stitches of Sternlieb). Said term does not imply any spacing of said stitch yarns. Thus, the features upon which applicant relies (i.e., yarn faces which are effectively continuous such that the web is not exposed) are not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Therefore, the rejection of claims 30-37 and 51-64 as being anticipated by the cited Lefkowitz patent is hereby maintained.

32. With respect to the Ott and Gillies anticipation rejections, Applicant argues that the disclosed stitches per inch produces a "low" stitch density, which necessarily creates "large open gaps rather than an effectively continuous face" (Response, page 9, line 13-page 10, line 2). As argued above, the spacing of the stitch yarns which provide an "effectively continuous" yarn face is not presently claimed. Therefore, said anticipation rejections are maintained.

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33. Regarding the 103 obviousness rejections, it is noted that Applicant has not separately addressed said rejection, but rather (presumably) relies upon the traversal of the anticipation rejections. Since said anticipation rejections have been maintained, said obviousness rejections have also been maintained.

***Conclusion***

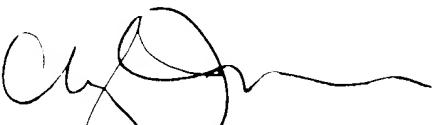
34. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

35. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheryl Juska whose telephone number is (703) 305-4472. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be

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reached at (703) 308-2414. The official fax number for this TC 1700 is (703) 872-9310 and, for After Final communications, (703) 872-9311.



CHERYL JUSKA  
PATENT EXAMINER

cj

April 24, 2001